



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/810,773

03/26/2004

Jasna Roeth

LEAP:125US

9680

7590

03/31/2006

Robert P. Simpson, Esq.  
Simpson & Simpson, PLLC  
5555 Main Street  
Williamsville, NY 14221-5406

EXAMINER

LAVARIAS, ARNEL C

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 03/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/810,773

Applicant(s)

ROETH ET AL.

Examiner

Arnel C. Lavarias

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 1/17/06, 9/7/04, 3/26/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 12-15 and 24-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 16-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/7/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of Invention I (Claims 1-10, 17-23) in the reply filed on 1/17/06 is acknowledged.
2. Claims 12-15, 24-33 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 1/17/06.

### *Priority*

3. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 120.

### *Drawings*

4. The originally filed drawings were received on 3/26/04. These drawings are objected to for the following reason(s) as set forth below.
5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "30" has been used to designate both a slide mount glide (See Paragraph 0021) and a slide mount guide (See Paragraph 0024). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of

an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

*Specification*

6. The disclosure is objected to because of the following informalities:

Paragraph 0010, line 2- 'be' should read 'by'.

Appropriate correction is required.

7. The attempt to incorporate subject matter into this application by reference to the following documents (See *infra*) is ineffective because the reference documents are not clearly identified as required by 37 CFR 1.57(b)(2).

"Releasable/Interchangeable Fine Focus Knob for a Microscope" (See Paragraph 0016)

"Ergonomically Arranged Object Adjustment Controls" (See Paragraph 0016)

"Shielded-Ergonomic Microscope Stages" (See Paragraph 0016)

"Lamp Assembly for a Microscope" (See Paragraph 0016)

"Means for Transporting a Microscope" (See Paragraph 0016)

8. The incorporation by reference will not be effective until correction is made to comply with 37 CFR 1.57(b), (c), or (d). If the incorporated material is relied upon to meet any outstanding objection, rejection, or other requirement imposed by the Office, the correction must be made within any time period set by the Office for responding to the objection, rejection, or other requirement for the incorporation to be effective.

Art Unit: 2872

Compliance will not be held in abeyance with respect to responding to the objection, rejection, or other requirement for the incorporation to be effective. In no case may the correction be made later than the close of prosecution as defined in 37 CFR 1.114(b), or abandonment of the application, whichever occurs earlier.

Any correction inserting material by amendment that was previously incorporated by reference must be accompanied by a statement that the material being inserted is the material incorporated by reference and the amendment contains no new matter. 37 CFR 1.57(f).

9. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

Claims 5, 9, and 18 all recite the limitation 'a spring-loaded ball bearing'. However, neither the specification nor the drawings of the instant disclosure specifically disclose or show that the first or second engagement means may be anything other than a set screw. In addition, it is not readily evident how a spring-loaded ball bearing may detachably secure a stage drive mechanism to the microscope stage.

### ***Claim Objections***

10. Claim 20 is objected to because of the following informalities:

Claim 20 recites the limitation "said slide holder" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Appropriate correction is required.

### ***Double Patenting***

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1-2, 6, 10-11, 16, 23 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-34 of copending Application No. 10/810979 (U.S. Patent Application Publication US 2005/0111093 A1). Although the conflicting claims are not identical, they are not patentably distinct from each other because copending Application No. 10/810979 similarly discloses a microscope stage assembly (See for example Claim 1) comprising a stage (See Claim 1); first engagement means for a microscope stage drive mechanism at a first location on the stage (See Claim 8); and second engagement means for the microscope stage mechanism at a second location on the stage (See Claim 8); the first and second locations further

comprising a rack operatively arranged to engage the microscope stage drive mechanism (See Claims 9, 11); the microscope stage assembly in combination with a microscope (See Claims 18, 24); and the microscope stage assembly in combination with a microscope stage drive mechanism (See Claims 9, 11). Copending Application No. 10/810979 additionally discloses an interchangeable microscope stage drive assembly (See for example Claim 1) comprising a microscope stage (See Claim 1); and a drive mechanism detachably securable to the microscope stage at more than one location of the stage (See Claim 7); and the assembly in combination with a microscope (See Claims 18, 24).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1-2, 4, 6, 8, 10-11, 16-17, 20, 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Stahl et al. (U.S. Patent No. 4402576).

Stahl et al. discloses a microscope stage assembly (See Figure) comprising a stage (See 10, 11 in Figure); first engagement means for a microscope stage drive mechanism (See for example 21, 23 in Figure) at a first location on the stage (See for example 17 and

various screws in Figure); and second engagement means for the microscope stage mechanism at a second location on the stage (See for example 17 and various screws in Figure). Stahl et al. additionally discloses the first and second locations further comprising a rack operatively arranged to engage the microscope stage drive mechanism (See for example 32, 35 in Figure); the first and second engagement means further comprising a set screw (See for example 17 and various screws in Figure) to detachably secure the stage drive mechanism to the stage; the microscope stage assembly in combination with a microscope (See Figure; Abstract); and the microscope stage assembly in combination with a microscope stage drive mechanism (See 21, 23 in Figure; Abstract). Stahl et al. further discloses an interchangeable microscope stage drive assembly (See Figure) comprising a microscope stage (See 10, 11 in Figure); and a drive mechanism detachably securable to the microscope stage at more than one location of the stage (See 21, 23, 17, 17, various screws in Figure). Stahl et al. additionally discloses a set screw to detachably secure the stage drive mechanism to the stage (See 17, various screws in Figure); a rack and pinion operatively arranged to effect lateral movement of the slide holder (See for example 10, 21, 34, 35 in Figure) and forward and backward movement of the stage (See for example 10, 11, 23, 32, 33 in Figure); and the assembly in combination with a microscope (See Figure; Abstract).

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:



Art Unit: 2872

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 3, 7, 19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stahl et al. in view of Kanao (U.S. Patent No. 5802925).

Stahl et al. discloses the invention as set forth above in Claims 1 and 16, except for the first and second locations further comprising a belt and pulley operatively arranged to engage the microscope stage drive mechanism, so as to effect lateral movement of the slide holder and/or forward and backward movement of the stage. However, the use of belts and pulleys as an alternative means of moving microscope stages and slide holders is known in the art. For example, Kanao teaches a conventional microscope stage (See for example Figures 1-2, 8-9), wherein stage and sample slide movement in both the x (lateral) and y (forward and backward) directions may be effected by either rack and pinion or, more advantageously, belt and pulley (See for example 8, 9a-b, 10a-b, 11 in Figure 1). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the first and second locations further comprise a belt and pulley operatively arranged to engage the microscope stage drive mechanism, so as to effect lateral movement of the slide holder and/or forward and backward movement of the stage, as taught by Kanao, in the assembly of Stahl et al., for the purpose of effecting smooth and stable operational movement of the stage without receiving resistance of movement from the stage drive mechanism.

17. Claims 5, 9, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stahl et al. in view of Chambers et al. (U.S. Patent No. 3428387).

Stahl et al. discloses the invention as set forth above in Claims 1 and 16, except for the first and second engagement means further comprising a spring-loaded ball bearing to detachably secure the stage drive mechanism to the stage. However, Chambers et al. teaches a conventional friction driven microscope stage drive mechanism (See for example Figures 2-3), wherein the stage drive mechanism (See 36, 48 in Figure 3) may further include a pressure roller and spring clip (See for example 34, 35 in Figure 3) to maintain engagement with the stage drive mechanism. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the first and second engagement means further comprise a spring-loaded ball bearing to detachably secure the stage drive mechanism to the stage, as taught by Chambers et al., in the assembly of Stahl et al., to provide continuous contact with the stage drive mechanism while preventing contact slipping of the stage drive mechanism during use.

### ***Conclusion***

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arnel C. Lavarias whose telephone number is 571-272-2315. The examiner can normally be reached on M-F 9:30 AM - 6 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2872

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Arnel C. Lavarias  
Patent Examiner  
Group Art Unit 2872  
3/29/06